

### **REMARKS**

The present Amendment is in response to the Examiner's Office Action mailed May 9, 2007. Claims 2 and 4 are cancelled, claims 1, 11, 13, and 25 are amended, and no new claims are added. Claims 1, 3, and 6-32 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

#### **I. General Considerations**

Applicants note that the remarks and amendments, or a lack of remarks, herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; as to the whether any references were properly combined, or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Further, Applicants reserve the right to challenge the purported teaching and prior art status of, as well as the motivation to combine, the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicants, of additional or alternative distinctions between the claims of the present application and any references cited by the Examiner, and/or the merits of additional or alternative arguments.

## **II. Drawings**

The Office Action objects to the drawings on the grounds that a “secondary circuit” is not shown. Applicants have replaced “secondary circuit” with “flexible circuit” in the pending claims. A “flexible circuit” is shown in Figures 2 and 3. Accordingly, Applicants respectfully request that the objection to the claims be withdrawn.

## **III. Rejection Under 35 U.S.C. § 112, Second Paragraph**

The Office Action rejects claims 1-4 and 6-12 under 35 U.S.C. § 112, Second Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, Applicants have amended claims 1 and 11 to replace “secondary circuit” with “flexible circuit”. Such amendments are supported by at least Figures 2 and 3 and paragraph [0043] of the originally filed specification. Applicants note that the cancellation of claims 2 and 4 renders the rejection of these claims moot. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, Second Paragraph to the claims 1 and 11 be withdrawn.

## **IV. 35 U.S.C. § 112, First Paragraph**

The Examiner rejects claims 1-4 and 6-12 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement because of the term “secondary circuit” in the claims. In response, Applicants have amended claims 1 and 11 to replace “secondary circuit” with “flexible circuit”. Such amendments are enabled by at least Figures 2 and 3 and paragraph [0043] of the originally filed specification. Applicants note that the cancellation of claims 2 and 4 renders the rejection of these claims moot. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, First Paragraph to the claims 1 and 11 be withdrawn.

## **V. Rejections Under 35 U.S.C. § 103**

### **A. Claims 1-4 and 6-12**

The Office Action rejects claims 1-4, 6-13 and 18-24 under 35 U.S.C. § 103 as being unpatentable over United States Patent No. 6,580,531 to Swanson et al. (“Swanson”) Claim 4 was further rejected in view of United States Patent No. 5,575,998 to Thatcher (“Thatcher”).

Applicants respectfully traverse this characterization for at least the reasons that will now be discussed.

Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Office Action to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143. As an initial matter, Applicants note that the cancellation of claims 2 and 4 render the rejection of these claims moot.

As shown above, Applicants have amended claim 1 to recite in part “forming a temporary electrical connection between a flexible circuit and the electrical interface of the tester apparatus, wherein the flexible circuit is in electrical communication with the OSA, the flexible circuit being disposed between the OSA and the electrical interface. . . .” Support for such amendments is found at least in Figures 2 and 3 and paragraphs [0041]-[0051] of the specification.

In sharp contrast, Swanson does not teach or suggest having a flexible circuit disposed between the OSA and the electrical interface. For example, only optical transmitter 8 or optical receiver 9 can reasonably be considered an OSA. However, it is clear from Figures 1 and 7 of Swanson that there is not a flexible circuit disposed between the alleged electrical interfaces and optical transmitter 8 or optical receiver 9. In fact, Figure 2 of Swanson, which shows the internal circuitry of optical transmitter 8 or optical receiver 9, would not need a flexible circuit as recited in amended claim 1 and indeed is not configured to have such a flexible circuit added to it.

Thatcher, which is used by the Office Action to show the use of flexible circuits, does not teach a flexible circuit as recited in claim 1. Accordingly, the Applicants respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claims 1, 3, and 6-12, at least because the Office Action has failed to show that the recited art, either singularly or in combination, teaches or suggests all of the claim limitations of claim 1. Applicant thus respectfully submits that the obviousness rejection of claim 1, 3, and 6-12 should be withdrawn.

**B. Claims 13 -24**

The Office Action rejects claims 13 and 18-24 under 35 U.S.C. § 103 as being unpatentable over Swanson. Claims 14-17 are further rejected in view of United States Patent No. 6,765,396 to Barror ("Barror"). Applicants respectfully traverse this characterization for at least the reasons that will now be discussed.

Applicants initially note that the Office Action appears to be taking the view that the "base member" recited in claim amended 13 is inherent in Swanson. Applicants respectfully note, however, that inherency is not readily established. For example, as noted in MPEP § 2112, the Office Action must provide rationale or evidence showing inherency. In particular, "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original). Moreover, the Court of Appeals for the Federal Circuit has noted that "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described by the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added).

Finally, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Office Action has not met this burden in showing that a base member is inherent in Swanson. In other words, the Office Action has not shown that a test circuit as recited in claim 1 must be placed on a base member. In fact, if the test circuit of Swanson contains all the elements that the Office Action says it does, then it would be impracticable to include the test circuit in base member as the base member would be far too large for practical use.

However, in conjunction with the above, Applicants have amended claim 13 to recite in part "a printed circuit board having a test circuit formed thereon, the printed circuit board being disposed on the base member. . ." Support for such amendment is found at least in Figures 1-3 and their accompanying text.

The Office Action, however, has not shown this element of amended claim 1. Indeed, as mentioned above, if the test circuit of Swanson contains all the elements that the Office Action says it does, then it would be impracticable to include the test circuit in a printed circuit board as the board would be far too large for practical use.

In light of the foregoing, Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 13 at least because the Office Action has not established that the references, either alone or in combination, teach or suggest all the limitations of claim 13. Accordingly, Applicants request that the rejection of claims 13 and 18-24 under 35 U.S.C. § 103 be withdrawn.

Dependent claims 14-17 depend from claim 13 and therefore include all of the limitations of amended independent claim 13. As discussed above in relation to amended independent claim 13, Swanson does not teach or suggest all of the limitations of amended claim 13. Barror does not teach the limitations of amended independent claim 13 missing in Swanson and is not cited by the Office Action as teaching such. Accordingly, even the purported combination of Swanson and Barror does not teach or suggest all of the limitations of claim claims 14-17. The Office Action has thus not shown a *prima facie* case of obviousness and the rejection under 35 U.S.C. § 103(a) to claims 14-17 should be withdrawn.

### **C. Claims 25-32**

The Office Action rejects claims 25-32 under 35 U.S.C. § 103 as being unpatentable over Swanson in view of Barror. Applicants note the Office Action fails to give any reasons for the rejection of independent claim 25. Applicants will nonetheless address this claim and its dependent claims.

As noted above, Applicants have amended claim 25 to recite in part “a clamping assembly pivotably mounted to the base member, the clamping assembly configured for temporarily placing the optical subassembly in temporary electrical connection with the electrical interface, the clamping assembly including a lever, a link member, a head member, and a clamping member.” Support for such amendments is found at least at Figures 4A and 4B and paragraph [0052] of the specification.

In sharp contrast, the Office Action has not shown that Swanson and/or Barror, either singularly or when combined in the allegedly obvious manner, teaches or suggests a clamping

assembly as recited in amended claim 25. Accordingly, the Applicants respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claims 25-32, at least because the Office Action has failed to show that the recited art, either singularly or in combination, teaches or suggests all of the claim limitations of claim 25. Applicant thus respectfully submits that the obviousness rejection of claim 25-32 should be withdrawn.

### CONCLUSION

In view of the foregoing, Applicants believe the claims as amended or presently pending are in allowable form and that every issue raised by the Office Action has been addressed. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorneys.

Dated this 24th day of August, 2007.

Respectfully submitted,



ERIC L. MASCHOFF  
Registration No. 36,596  
SHANE K. JENSEN  
Registration No. 55,301  
Attorneys for Applicant  
Customer No. 22913  
Telephone: (801) 533-9800